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EXAMINER	
KANG, ROBERT N	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/987,529	HINO, YASUHIRO	
	Examiner	Art Unit	
	Robert N. Kang	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,13,14,16-26,28,29,31 and 35-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13,14,16-26,28,29,31 and 35-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Response to Arguments

1. Applicant's arguments filed in the Request for Continued Examination dated 6/05/2006 have been fully considered but they are not persuasive.

2. With regards to the modification of Nehab disclosed by the Examiner in office action dated 1/20/2006, the applicant has not traversed the examiner's assertion of official notice. MPEP 2144.03 states "a general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate... If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because the applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate." Therefore the fact that client/server system architecture was well known at the time of invention can now be regarded as prior art.

3. Independent claims 1, 11, 14, 17, 26, 29, and 35-37 recite the newly added limitation "an output unit adapted to output the image on the recording medium based on the data for output by said acquisition unit," or a method step of utilizing the output unit. Applicant states on page 15, paragraph 3, "the image forming apparatus includes an output unit adapted to output the image on the recording medium based on the data for output acquired by an acquisition unit. The image forming apparatus, which includes

the output unit, sends the acquisition information and the layout information to an external apparatus. In Nehab et al., on the other hand, personal-news-profile 19 is stored in disk 5 of the host machine. Web printer 17 receives a personal news profile from the personal news profile 19. Web printer 17, however, does not send the personal-news-profile to any external apparatus."

Examiner references the Nehab invention modified in view of traditional client-server architecture, as cited in the previous office action. In this modification, the web printer itself 17 is the "external apparatus" which "receives" the locally personal news profile stored in the disk 5 of a separate host machine. Additionally, Nehab discloses in column 12, lines 58 to 63, "the formatted and fully personalized newspaper is sent to output interface 40. This interface could be printer interface 10 to printer 7." Obviously, since modified Nehab invention places the client separate from the server, it would make sense to send the flattened personalized newspaper to the requesting client printer, or the "image forming apparatus" at the client side. Thus this limitation is already met by Nehab's invention and the applicant's argument is unpersuasive.

4. Independent claims 11, 26, and 36 include the additional limitations of "a changing unit adapted to change a portion of the layout information received by said reception unit in accordance with a function or state of said image forming apparatus, wherein the portion of the received layout information does not correspond to the function or state of said image forming apparatus and another portion of the received layout information corresponds to the function or state of said image forming

apparatus." Applicant states in paragraph 3 of page 16, "in Nehab et al., either the user designated personal news profile or the default personal news profile is selected. A portion of the user designated personal news profile is not changed."

The applicant has clearly confused the entire personal news profile with merely the formatting template, which is simply part of the personal-news-profile (appendix 2). The personal news profile includes formatting instructions which can either be user defined, or default (col. 6, lines 63-66). The user defined formatting instructions may be set up in accordance with the fonts and colors available to the user based on the system's printer capabilities (col. 10, lines 9-13). Thus, a "portion" of the personal news profile, the sites to be extracted and extraction rules, remains unchanged, while another "portion" of the personal news profile, the formatting instructions, is changed in accordance with the "function or state" of the image forming apparatus, i.e., a default formatting template is used when the printer is incapable of various fonts or colors, and the user defined formatting template is utilized when the printer is capable of various fonts and/or colors.

5. Applicant's arguments with respect to claims 14, 29, and 39 have been considered but are unpersuasive. The applicant states that "in Nehab, the user must edit the personal news profile in accordance with the function or state of the image forming apparatus. Even the default personal news profile is not determined by the web printer 17, but is edited by the user." This is simply erroneous, as there is no mention in Nehab that the default formatting template is edited by the user. As commonly known in

the industry, a default print formatting or setting is based upon the most basic capabilities the printer is capable of. Furthermore, a printer wherein the default setting is to print in color which has run out of color ink or toner will either prompt the user to print in monochrome or automatically print in monochrome. These are concepts which are well known in the art and therefore, inherent in all default print settings and/or output formatting instructions. Examiner references another example, Yamada (US-PAT 6,798,538) which adjusts the rasterization dpi based upon the print resolution capabilities of the printer. Thus the default formatting template, which is utilized when user specified formatting instructions are not included, "determines layout information in accordance with a function or state of the image forming apparatus."

All the applicant's arguments have been traversed and are therefore rejected under 35 U.S.C. 103(a) by the modified Nehab invention as disclosed in the final rejection dated 2/28/2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-11, 13, 14, 16-26, 28, 29, 31, and 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab (US-PAT 6,029,182) in view of traditional client/server architecture (official notice).

Regarding claims 1 and 17, Nehab discloses both a printing method and system which meets the aforementioned claim limitations. Nehab discloses in Figure 1 a printer 7, communicably attached to host PC 1 via printer interface 10 as shown in figure 2. By definition, a printer qualifies as "an image forming apparatus capable of outputting an image on a recording medium based on data described with a structured description language." This description language may either be a PDL file, hypertext, simple text, markup language, or bit maps generated from the printer device driver. Specifically regarding Nehab's patented system, Nehab discloses in column 13, lines 22-29, an HTML formatter comprised in the WebFormatter embodiment, which "extracts data from a web page, strips out extemporaneous data from the extracted data, and reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor." Therefore printed data on the medium "is described by a structured description language."

Regarding the second limitation, which requires that the image forming device possess "an informing means for informing, to an external apparatus, information for acquiring data and layout information necessary for assigning an image based on the data to the recording medium," Nehab discloses a WebPrinter program with a graphical user interface as shown in figure 6. As described in column 10, lines 65-67, the "web printer 17 instructs web reader 34 to connect o the web via web server 35 in order to

access various web sites and to retrieve data from those sites." Therefore, the image forming apparatus, comprised of the printer as well as the WebPrinter application, provides an external apparatus with information regarding the acquisition of data to be printed.

In regards to the third limitation, Nehab states in column 10, lines 66-67, that "Web reader 34 sends the retrieved data to web printer 17." Nehab further discloses in column 12 lines, 59-60, "in step 803, [of the flow chart of figure 8] "the formatted and fully personalized newspaper is sent to output interface 40. This interface could be printer interface 10 to printer 7." Therefore the image forming apparatus comprised of the printer and the WebPrinter application possesses a means "for acquiring data outputted from said external apparatus according to the information by said informing means."

Examiner takes Official Notice that Client/Server interactions were well known at the time of invention to those of normal skill in the art. The motivation of the client/server system architecture is obvious, to provide central hardware/software for the execution of programs or applications throughout a distributed system without the added costs and complexity of providing application-specific hardware and/or software to every client host machine in a network.

Ergo, it would have been obvious at the time of invention to those of normal skill in the art to implement Nehab's invention as a server since Examiner takes official notice that client/server architecture was well known in the art.

The most logical method of implementation allows flexibility in defining user parameters on a local machine and sending said profiles to a server. This is most obviously achieved by drawing a horizontal line on figure 6 between the web printer 17 and the site profile 20 and personal news profile 19 (these are embodied within the personal news profile editor application 16). Obviously, this horizontal line represents a network connection between the host machine containing elements 19 and 20, and the web printer 17. Therefore, the output interface 40 would go through the network interface back to the host computer, as defined by well-established network architecture in the field of client/server interactions. Therefore, the server including the web printer 17, site driver 51, web reader interface 50, and web reader 34 now qualifies as the "external apparatus."

Because the personal-news-profile 19 contains format information in a template, the "image forming apparatus," comprising the host machine and the printer, sends acquisition information for acquiring data and layout information necessary for assigning an image to an external apparatus or acquiring data for output from the external apparatus."

Referencing figures 7 and 8, the "external apparatus," after receiving the personal news profile 19 in step S701, retrieves the data via the web reader in S704, and formats the linear document according to the template stored in personal news profile in S802. The formatted newspaper is then sent out the output interface in S803, which, in light of the modification, sends back to the host PC. Therefore, the modified Nehab invention "sends layout information to an external apparatus to cause the

external apparatus to generate data for output based on the sent layout information, and acquires the data for output generated by the external apparatus."

Nehab states in column 8, lines 27-28, "In step S500 of FIG 5A, a personal-news-profile editor 16 is launched by a user." The personal-news-profile 16 comprises layout and acquisition information, which is gathered for the first time from a user in steps S505-S510. Therefore, the image forming apparatus's "reception means" is the graphical user interface between the user and the application as shown in figures 9a-9e and as described by Nehab in column 9, lines 36-38, "personal-news-profile editor 16 may be invoked as a graphical user interface which allows a user to edit a previously stored personal-news-profile."

The layout editor 39 functions as a "changing means for changing the layout information received by the reception means" from the user. Nehab states in column 10, lines 12-14, that the "layout editor 39 is capable of determining the types of fonts and colors available to the user based on the system's printer capabilities." Therefore layout information received in the form of the personal-news-profile 19 from the user is changed by the layout editor 39, which is in turn sent to the external apparatus "so as to cause the external apparatus to generate data for output based on the sent layout information."

Finally, Nehab discloses in column 6, lines 63-65, a formatter 42 implemented within the web printer 17 which formats the linear document "according to user-specified (or default) formatting instructions into formatted document 33." This default formatting instruction is utilized when a user template is not defined as shown in appendix 2,

column 22, line 30. The default format is determined by the format editor 39 shown in figure 4. Therefore, the if personal new profile 19 does not include any layout information, the format editor 39 in personal news profile editor 16, stored in the image forming apparatus, sets a default format and sends the request to the external apparatus. Therefore, the "image forming apparatus comprises ... a determination unit adapted to determine layout information required for assigning an image based on data to the recording medium, if the received printinstruction does not include any layout information for the data."

Thus, the Nehab invention in a server configuration meets all of the asserted novelties of the pending application, "without departing from the spirit and scope of the appreciated claims," as stated by Nehab in column 19, lines 55-60, through a minor modification of system architecture.

With regards to claim 35, Nehab's method and image forming system expressly discloses the applicant's method. Additionally, Nehab explicitly states that his printing system may be embodied within an application program stored within a memory medium. Nehab states in column 5 line 59 to column 6 line 6, "Main memory 14 interfaces with computer bus 9 so as to provide random access memory storage for use by CPU 8 when executing an application such as personal-news-profile editor 16 or Web printer 17. More specifically, CPU 8 loads these software applications from disk drive 5 into main memory 14 and executes the software applications out of main memory 14. In accordance with user instructions, stored application programs are

activated which permit processing and manipulation of data. Typically, the software applications stored on disk drive 5, such as personal-news-profile editor 16, Web printer 17, and HTML formatter 18, have been stored on disk drive 5 by downloading the software applications from a computer-readable medium such as a floppy disk or CD ROM, or by downloading the software applications from a computer bulletin board." Therefore the Nehab patent specifically predicts the memory medium storing a program as claimed by claim 32 as well as the program to be executed as claimed in claim 35.

With regards to claims 2 and 18, Nehab states in column 10, lines 48-50, "figure 6 is a representational block diagram of the matter by which the invention retrieves articles from the web according to personal-news-profile 19." Figure 6 shows that the information sent by the web printer 17 to the web reader 34 is determined based upon the personal-news-profile 19. Nehab discloses in column 7, lines 24-26, "to create the personal-news-profile19, personal-news-profile editor 16 communicates with personal-news-profile 19, site profile 20, and web reader 34." Nehab also states in column 7, lines 27-28, "personal-news-profile 19 contains information as to what sites to access, what sections to retrieve from those sites, rules to be used to determine what data to extract from the sections and the article therein, rules to determine how to exclude links, and newspaper format information." Therefore, the "information for acquiring the data and layout information" transmitted from the image forming apparatus to the web reader 34 is also "information for identifying the data."

Regarding claims 3 and 19, Nehab states in column 7 lines 39-42 "because general site information is stored in site profile 20, personal-news-profile 19 can refer to the general site information with reference to site profile, 20, saving space in the personal-news-profile." Therefore the information in site profile 20 is incorporated by reference into the personal news profile provided by the informing means. As seen in appendix 1, the information for identifying the data includes both a site URL as well as a section/document URL, thus meeting the limitation "information for acquiring the data is represented by URI," since the two terms both identify a web resource by address/location.

With regards to claims 4 and 20, as defined in previous claim rejections, Nehab's image forming apparatus is comprised of the printer and the WebPrinter application. Therefore, the connection through program memory between the WebPrinter application, the personal-news-profile 19, and the site profile 20 qualifies as a reception means. In response to a print command executed by the user to the WebPrinter application, the WebPrinter program in step 502 of figure 5a gets the user's personal ID, which includes "information indicating the position of storage data and said layout information." This information is then transmitted through the informing means to the web reader and thus, the external web server apparatus, as disclosed above. Therefore "the informing means informs information included in said print instruction."

Regarding claims 5 and 21, the web reader retrieves 34 retrieves document data via a web server 35 via network interface 11a. As stated by Nehab in column 5, lines 47-50, "network interface 11a is used to connect computing equipment 1 to a local area network (LAN) or to a wide area network (WAN) such as the World Wide Web." Therefore, the "acquisition means acquires the data through a network."

Regarding claims 6 and 22, Nehab depicts in appendix 1 within each personal-news-profile a field is listed for assembling the document in accordance with a given template, as shown in the last line of the sample user profile. Nehab states in column 8, lines 15-18, "each document template specifies page layout information, font information, style information, colors, etc. for the title, indices/headings, subheadings, text and the like for a personalized newspaper." Broadly defined, "page layout information" includes both sheet size as well as the direction of printing (portrait/landscape). This can be evidenced by simply opening the advanced page layout properties in the print dialogue box of Microsoft Word 7.0, released in 1998, or any other printer driver or graphics/word processing program released after 1998. Therefore, Nehab's invention broadly encompasses the recited limitations of claims 6 and 22.

With regards to claims 7 and 23, Nehab discloses in column 7, lines 27-28, "a personal-news-profile 19 contains information as to what sites to access, what sections to retrieve from those sites, rules to be used to determine what data to extract from the

sections and the article therein, rules to determine how to exclude links, and newspaper format information." By determining which sections to retrieve from a given website, broadly defined, the personal-news-profile executes the function of "designating a page [or pages] and said acquisition means acquires data corresponding to the designated page [or pages]." Furthermore, since the personal-news-profile encompasses both the data acquisition as well as the page layout information, it may be asserted that "layout information is information designating a page."

Regarding claims 8 and 24, Nehab discloses in column 13, lines 22-29, an HTML formatter comprised in the WebFormatter embodiment, which "extracts data from a web page, strips out extemporaneous data from the extracted data, and reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor." Therefore, the "said structured description language is either XML or HTML."

In regards to claims 9 and 25, the examiner has defined the "image forming apparatus" used in the claim rejections to embody the following components of Nehab's patent: the application software 15, the printer interface 10, and the printer 7. Therefore, "the image forming apparatus according to claim 1" qualifies as "a printing apparatus." Additionally, the method claimed in claim 17 is carried out within a printing apparatus.

In regards to the independent claim 10, Nehab discloses both a printing method and system which meets the claim limitations. Nehab discloses in Figure 1 a printer 7, communicably attached to host PC 1 via printer interface 10 as shown in figure 2. By definition, a printer qualifies as "an image forming apparatus capable of outputting an image on a recording medium based on data described with a structured description language." This description language may either be a PDL file, hypertext, simple text, markup language, or bit maps generated from the printer device driver. Specifically regarding Nehab's patented system, Nehab discloses in column 13, lines 22-29, an HTML formatter comprised in the WebFormatter embodiment, which "extracts data from a web page, strips out extemporaneous data from the extracted data, and reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor." Therefore printed data on the medium "is described by a structured description language."

Regarding the second limitation, which requires that the image forming device possess "an informing means for informing, to an external apparatus, information for acquiring data and layout information necessary for assigning an image based on the data to the recording medium," Nehab discloses a WebPrinter program with a graphical user interface as shown in figure 6. As described in column 10, lines 65-67, the "web printer 17 instructs web reader 34 to connect o the web via web server 35 in order to access various web sites and to retrieve data from those sites." Therefore, the image forming apparatus, comprised of the printer as well as the WebPrinter application,

provides an external apparatus with information regarding the acquisition of data to be printed.

In regards to the third limitation, Nehab states in column 10, lines 66-67, that "Web reader 34 sends the retrieved data to web printer 17." Nehab further discloses in column 12 lines, 59-60, "in step 803, [of the flow chart of figure 8] "the formatted and fully personalized newspaper is sent to output interface 40. This interface could be printer interface 10 to printer 7." Therefore the image forming apparatus comprised of the printer and the WebPrinter application possesses a means "for acquiring data outputted from said external apparatus according to the information by said informing means." Therefore the limitations of claims 1 and 17 are met.

Regarding the fourth and fifth limitations, Nehab discloses in column 11, lines, 29-24, a formatter 42 embodied within web printer 17, which "is responsible for flattening the extracted data tree into a linear document and formatting the linear document into a personalized newspaper. Formatter 42 performs these functions in accordance with the print criteria and format information (i.e., newspaper template) indicated in personal-news-profile 19." This is a "conversion means for converting the acquired data based on said layout information." Nehab, however, implements his conversion means within the application program of the image forming apparatus as defined in previous rejections, thus it is not an "external apparatus" as claimed in the preamble of claim 10. However, Nehab states in column 19 lines 54-59, "it is to be understood that the invention is not limited to the above described embodiments and modifications thereto, and that various changes and modifications may be made by

those of ordinary skill in the art without departing from the spirit and scope of the appended claims." Therefore, to include the formatter 42 in the application memory of the web server 35 would have been an obvious modification to reduce processor load on the image forming apparatus and enable widespread distribution to various image forming apparatuses, which does not depart from the spirit and scope of the claims.

Specifically regarding the fifth limitation, Nehab depicts in figure 6 a distinct data transmission path to and from the image forming apparatus. The network interface 11a connects the web server 35 to the image forming apparatus application program 17. In the event of a simple modification as recited in the preceding paragraph, the "transfer means" through network interface 11a is used "for transferring the converted data from said external apparatus to said image forming apparatus."

Regarding the final limitation of claim 10, Nehab discloses in column 12 lines, 59-60, "in step 803, [of the flow chart of figure 8] "the formatted and fully personalized newspaper is sent to output interface 40. This interface could be printer interface 10 to printer 7." Printer engines as commonly known in the art receive and interpret print commands from the device driver into patterns and locations to dispense print toner or ink to form an image; this process qualifies as "analyzing the transferred data." Therefore, Nehab's invention possesses "an output means for outputting an image by analyzing the transferred data."

Regarding claims 11 and 26, Nehab discloses both a printing method and system which meets the claim limitations. Nehab discloses in Figure 1 a printer 7,

communicably attached to host PC 1 via printer interface 10 as shown in figure 2. By definition, a printer qualifies as "an image forming apparatus capable of outputting an image on a recording medium based on data described with a structured description language." This description language may either be a PDL file, hypertext, simple text, markup language, or bit maps generated from the printer device driver. Specifically regarding Nehab's patented system, Nehab discloses in column 13, lines 22-29, an HTML formatter comprised in the WebFormatter embodiment, which "extracts data from a web page, strips out extemporaneous data from the extracted data, and reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor." Therefore printed data on the medium "is described by a structured description language."

In regards to the first limitation, the image forming apparatus, defined as in previous rejections as the printer 7, the printer interface 10, the output interface 40, and the software application 15, receives a print instruction in step S500 of figure 5a. Nehab states in column 8, lines 27-28, "In step S500 of FIG 5A, a personal-news-profile editor 16 is launched by a user." As stated numerous times in this office action, the personal-news-profile 16 comprises layout and acquisition information, which is gathered for the first time from a user in steps S505-S510. Therefore, the image forming apparatus's "reception means" is the graphical user interface between the user and the application as shown in figures 9a-9e and as described by Nehab in column 9, lines 36-38,

"personal-news-profile editor 16 may be invoked as a graphical user interface which allows a user to edit a previously stored personal-news-profile."

Regarding the second limitation, the layout editor 39 functions as a "changing means for changing the layout information received by the reception means" from the user. Nehab states in column 10, lines 12-14, that the "layout editor 39 is capable of determining the types of fonts and colors available to the user based on the system's printer capabilities." Therefore layout information received in the form of the personal-news-profile 19 from the user is changed by the layout editor 39.

Regarding the third limitation, which requires that the image forming device possess "an informing means for informing, to an external apparatus, layout information changed by said changing means." Nehab discloses a WebPrinter program with a graphical user interface as shown in figure 6. As described in column 10, lines 65-67, the "web printer 17 instructs web reader 34 to connect o the web via web server 35 in order to access various web sites and to retrieve data from those sites." Therefore, the image forming apparatus, comprised of the printer as well as the WebPrinter application, provides an external apparatus with information regarding the acquisition of data to be printed.

In regards to the fourth limitation, Nehab states in column 10, lines 66-67, that "Web reader 34 sends the retrieved data to web printer 17." Nehab further discloses in column 12 lines, 59-60, "in step 803, [of the flow chart of figure 8] "the formatted and fully personalized newspaper is sent to output interface 40. This interface could be printer interface 10 to printer 7." Therefore the image forming apparatus comprised of

the printer and the WebPrinter application possesses a means "for acquiring data outputted from said external apparatus according to the information by said informing means." Therefore the limitations of claims 11 and 26 are met.

With regards to claims 33 and 36, Nehab's method and image forming system expressly anticipates the applicant's method. Additionally, Nehab explicitly states that his printing system may be embodied within an application program stored within a memory medium. Nehab states in column 5 line 59 to column 6 line 6, "Main memory 14 interfaces with computer bus 9 so as to provide random access memory storage for use by CPU 8 when executing an application such as personal-news-profile editor 16 or Web printer 17. More specifically, CPU 8 loads these software applications from disk drive 5 into main memory 14 and executes the software applications out of main memory 14. In accordance with user instructions, stored application programs are activated which permit processing and manipulation of data. Typically, the software applications stored on disk drive 5, such as personal-news-profile editor 16, Web printer 17, and HTML formatter 18, have been stored on disk drive 5 by downloading the software applications from a computer-readable medium such as a floppy disk or CD ROM, or by downloading the software applications from a computer bulletin board." Therefore the Nehab patent specifically predicts the memory medium storing a program as claimed by claim 33 as well as the program to be executed as claimed in claim 36.

With regards to claims 13 and 28, Nehab depicts in appendix 1 within each personal-news-profile, a field is listed for assembling the document in accordance with a given template, as shown in the last line of the sample user profile. Nehab states in column 8, lines 15-18, "each document template specifies page layout information, font information, style information, colors, etc. for the title, indices/headings, subheadings, text and the like for a personalized newspaper." Broadly defined, "page layout information" includes paper sheet size. This can be evidenced by simply opening the advanced page layout properties in the print dialogue box of Microsoft Word 7.0, released in 1998, or any other printer driver or graphics/word processing program released after 1998. Therefore, Nehab's invention broadly encompasses the recited limitations of claims 13 and 28.

Regarding claims 14 and 29, Nehab discloses both a printing method and system which meets the claim limitations. Nehab discloses in Figure 1 a printer 7, communicably attached to host PC 1 via printer interface 10 as shown in figure 2. By definition, a printer qualifies as "an image forming apparatus capable of outputting an image on a recording medium based on data described with a structured description language." This description language may either be a PDL file, hypertext, simple text, markup language, or bit maps generated from the printer device driver. Specifically regarding Nehab's patented system, Nehab discloses in column 13, lines 22-29, an HTML formatter comprised in the WebFormatter embodiment, which "extracts data from a web page, strips out extemporaneous data from the extracted data, and

reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor." Therefore printed data on the medium "is described by a structured description language."

In regards to the first limitation, the image forming apparatus, defined as in previous rejections as the printer 7, the printer interface 10, the output interface 40, and the software application 15, receives a "print instruction" in step S500 of figure 5a. Nehab states in column 8, lines 27-28, "In step S500 of FIG 5A, a personal-news-profile editor 16 is launched by a user." The step S500 begins the automatic download process, which results in printing the personalized newspaper. Therefore, the image forming apparatus's "reception means" is the graphical user interface between the user and the application as shown in figures 9a-9e and as described by Nehab in column 9, lines 36-38, "personal-news-profile editor 16 may be invoked as a graphical user interface which allows a user to edit a previously stored personal-news-profile."

Regarding the second limitation, Nehab discloses in column 6, lines 63-65, a formatter 42 implemented within the web printer 17 which formats the linear document "according to user-specified (or default) formatting instructions into formatted document 33." This default formatting instruction is utilized when a user template is not defined as shown in appendix 2, column 22, line 30. The default format is determined by the format editor 39 shown in figure 4. Therefore the image forming apparatus and method possesses a "determination means for determining layout information required for

assigning an image based on the data to the recording medium, in case the received print instruction does not include said layout information."

Regarding the third limitation, which requires that the image forming device possess "an informing means for informing, to an external apparatus, layout information changed by said changing means." Nehab discloses a WebPrinter program with a graphical user interface as shown in figure 6. As described in column 10, lines 65-67, the "web printer 17 instructs web reader 34 to connect o the web via web server 35 in order to access various web sites and to retrieve data from those sites." Therefore, the image forming apparatus, comprised of the printer as well as the WebPrinter application, provides an external apparatus with information regarding the acquisition of data to be printed.

In regards to the fourth limitation, Nehab states in column 10, lines 66-67, that "Web reader 34 sends the retrieved data to web printer 17." Nehab further discloses in column 12 lines, 59-60, "in step 803, [of the flow chart of figure 8] "the formatted and fully personalized newspaper is sent to output interface 40. This interface could be printer interface 10 to printer 7." Therefore the image forming apparatus comprised of the printer and the WebPrinter application possesses a means "for acquiring data outputted from said external apparatus according to the information by said informing means." Therefore the limitations of claims 14 and 29 are met.

With regards to claim 37, Nehab's method and image forming system expressly anticipates the applicant's method. Additionally, Nehab explicitly states that his printing

system may be embodied within an application program stored within a memory medium. Nehab states in column 5 line 59 to column 6 line 6, "Main memory 14 interfaces with computer bus 9 so as to provide random access memory storage for use by CPU 8 when executing an application such as personal-news-profile editor 16 or Web printer 17. More specifically, CPU 8 loads these software applications from disk drive 5 into main memory 14 and executes the software applications out of main memory 14. In accordance with user instructions, stored application programs are activated which permit processing and manipulation of data. Typically, the software applications stored on disk drive 5, such as personal-news-profile editor 16, Web printer 17, and HTML formatter 18, have been stored on disk drive 5 by downloading the software applications from a computer-readable medium such as a floppy disk or CD ROM, or by downloading the software applications from a computer bulletin board." Therefore the Nehab patent specifically predicts the memory medium storing a program as claimed by claim 34 as well as the program to be executed as claimed in claim 37.

Regarding claims 16 and 31, Nehab depicts in appendix 1 within each personal-news-profile, a field is listed for assembling the document in accordance with a given template, as shown in the last line of the sample user profile. Nehab states in column 8, lines 15-18, "each document template specifies page layout information, font information, style information, colors, etc. for the title, indices/headings, subheadings, text and the like for a personalized newspaper." Broadly defined, "page layout information" includes paper sheet size. This can be evidenced by simply opening the

advanced page layout properties in the print dialogue box of Microsoft Word 7.0, released in 1998, or any other printer driver or graphics/word processing program released after 1998. Therefore, Nehab's invention broadly encompasses the recited limitations of claims 16 and 31.

With regards to claims 38 and 41, requiring "the data acquired in accordance with the acquisition information is described with a structured description language," referencing figures 7 and 8 of Nehab, the "external apparatus," after receiving the personal news profile 19 in step S701, retrieves the data via the web reader in S704, and formats the linear document according to the template stored in personal news profile in S802. The acquired data in Nehab's invention is a web page, which is always described via a structured description language such as HTML or CSS. Therefore, the apparatus as disclosed in 38 as well as the method as disclosed in claim 41 are unpatentable over the aforementioned modified-Nehab invention.

Regarding claims 39, 40, 42, and 43, the modified-Nehab invention is used to reject independent claims 11, 14, 26, and 29, respectively, upon which the claims depend. All the claims state the same limitation that "the external apparatus generates the data for output based on data described with a structured description language and the sent layout information." As stated in the preceding paragraph, the web page data, described by a structured description language (commonly HTML) is formatted by a formatter 42 implemented within web printer 17, which formats the linear document

"according to user-specified (or default) formatting instructions into formatted document 33." Therefore, the external apparatus generates the output to be sent back to the user based on the data described by a structured description language and the sent layout information.

Conclusion

Because the examiner has not introduced new grounds of rejection, nor was the after-final amendment un-entered because new issues were raised that required further consideration and/or search, **THIS ACTION IS MADE FINAL.** Please see MPEP 7.42.09 and 706.07(b).

A shortened statutory period for response to this action is set to expire 3 from the mailing date of this action.

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of

time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is 571-272-0593. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RNK

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SUPERVISORY PATENT EXAMINER